EV 175421509 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	
LUFFEL, Robert, W., *et al.*	Examiner: Tran, Khoa, H.
Serial No. 10/051,573	Art Unit: 3634
Filing Date: January 17, 2002	Conf. No.: 1003
For: LOW PROFILE SUPPORT SYSTEM FOR DEVICE RACK-MOUNTING	Atty. Dkt.: 10001582-5

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE

To: The Commissioner of Patents and Trademarks
P.O. Box 1450
Arlington, VA 22313-1450

Sir:

This communication is in response to the Notification of Non-Compliance, paper no. 8, dated June 2, 2003.

In the Notification of Non-Compliance, the examiner takes the position that the Appeal Brief fails "to state the grouping of the claims for each ground of rejection," in violation of the requirements of 37 CFR 1.192(c). Appellants respectfully disagree. The claims are grouped according to the various rejections applied thereto. For example, the Appeal Brief specifically identifies four issues as follows:

1. Whether claims 1-21 are indefinite under 35 U.S.C. Section 112, second paragraph;

2. Whether claims 1, 9, 11, and 13-16 are unpatentable under 35 U.S.C. Section 102(b) as being anticipated by Cherry;

3. Whether claims 1-4, 7-9, 11-19, and 21 are unpatentable under 35 U.S.C. Section 102(b) as being

- anticipated by Whiten; and

4. Whether claims 5, 6, 10, and 20 are unpatentable under 35 U.S.C. Section 103(a) as being obvious over Whiten and further in view of Robertson.

Because at least two different grounds of rejection are applied to each of the pending claims, appellants' statement that none of the pending claims stands or falls together is correct, as *among* the groupings. That is, each claim is separately argued in light of the different grounds of rejection in compliance with 37 CFR 1.192(c). For example, claim 1 is separately argued to be allowable in light of the Section 112 rejections applied to that claim, as well as the two separate anticipation rejections (i.e., the anticipation rejections based on Cherry and based on Whiten). These groupings are specifically identified in the "Issues" section presented on page 4 of the Appeal Brief.

However, *within* each rejection grouping, appellants acknowledge that separate arguments are not provided for certain of the claims in each grouping. However, that point is evident upon examining the arguments for each rejection grouping. For example, while claims 1-21 are rejected under Section 112, second paragraph, the nature of the rejections precludes a separate argument for each dependent claim, as the language identified by the examiner as being indefinite is contained in the independent claims. However, independent claims 14-16 are independently argued.

While the examiner correctly states that for the Section 102 rejection based on Cherry no separate argument is provided for claim 9, appellants respectfully disagree with the examiner's position that no separate argument is provided for claims 14 and 16. Claims 14 and 16 are independent claims that contain at least the same limitations as claim 1 that are not disclosed by Cherry. Appellants specifically identified and argued these limitations on page 10 of the Appeal Brief. Appellants also

specifically point out on page 10 that these limitations are separately contained in each of claims 14 and 16, which amounts to an argument that claims 14 and 16 are separately allowable over Cherry. Stated another way, to the extent that the argued limitations make claim 1 allowable over Cherry, the same limitations also make independent claims 14 and 16 separately allowable over Cherry.

Appellants make the same point with regard to claims 14 and 16 in relation to the Section 102 rejection based on Whiten. That is, claims 14 and 16 are independent claims that contain at least the same limitations as claim 1 that are not disclosed by Whiten. Page 12 of the Appeal Brief states that claims 14 and 16 contain at least these limitations, which amounts to an argument that claims 14 and 16 are separately allowable over Whiten. Therefore, to the extent that the argued limitations make claim 1 allowable over Whiten, the same limitations, which are present in claims 14 and 16, also make those claims separately allowable over Whiten.

With regard to the Section 103 rejections, appellants also disagree with the assertion that claim 20 is not argued as being separately allowable. Both claims 10 and 20 are argued to be separately allowable. Specifically, appellants argue that both claims 10 and 20 recite a sleeve which provides a spacing function to hold the "first device against the first side of the device opening." Claim 10, which depends from claim 1 via claim 9 is specifically argued as being allowable over the references because of this limitation. Similarly, claim 20, which depends from independent claim 16, is also specifically argued as being allowable over the references because of this same limitation. However, because these dependent claims are of different scope based on their different dependencies, they cannot be said to stand or fall together.

contradict

However, in an attempt to place the Appeal Brief in acceptable form, appellants include herewith an amended Appeal Brief in triplicate wherein the "Grouping of the Claims" section

is amended to identify those claims that stand for fall together within the particular ground of rejection.

Accordingly, appellants believe that the amended appeal brief filed concurrently herewith corrects the deficiencies noted by the examiner and is now fully compliant with 37 C.F.R. 1.192(c).

Respectfully submitted,

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